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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,894	02/14/2002	Akinori Iwase	065905-0249	6723

22428 7590 10/17/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

NGUYEN, THU V

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/073,894

Applicant(s)

IWASE ET AL.

Examiner

Thu Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The amendment filed on July 24, 2003 has been entered. By this amendment, claims 1-2, 5-11, 14-22 have been amended. Claims 12-13 have been canceled. Claims 1-11 and 14-22 are now pending in the application.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-11, 14-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,522,971 ('971 hereinafter). Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claims 1 and 14 basically claim a user terminal that transmits a desired destination data to a server, the server stores the information, and a printer prints a map from the position of the printer to the desired destination stored in the server on a recording medium. The main concept of the invention is taught in the independent claim 1 of '971 except that independent claim 1 of '971 does not explicitly disclose that the user terminal is portable and starting point of the printed map is at the printer position. However, the scope for the claimed "user terminal" of '971 extends to the portable device because the "user terminal" in '971 is taught as a portable device in fig.4 and fig.9A-9C. Moreover, since col.9, line 37-38 of '971 teaches that the starting point of the map can be any selected location, selecting the location of the printer as the starting point would have been obvious to an ordinary person skilled in the art. Further, according to claims 3-8, 17-19, saving the user ID and password at the server and charging fee to either the user or an advertising agency for the service would have been well known.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Jr. et al (US 5,197,009) in view of Stewart et al (US 6,259,405).

As per claim 1, Hoffman teaches an image forming system comprising a computer for receiving the destination data and a printer printing a map image from the location of the printer to the destination (col.4, lines 13-38). Hoffman does not explicitly teach a portable terminal for entering the destination to the server, and connecting the computer as a server, and the printer to a network. However, Hoffman teaches that the user can call in to provide his address (col.5, lines 38-40) and that the system of Hoffman can be connected to a central database in a network (col.5, lines 22-31; col.4, lines 56-65). Further, connecting a mobile device to a network and transmitting the destination from the mobile device to a server through a network, and connecting printers to a network is taught by Stewart (col.20, lines 5-28). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to connect the computer, the printer of Hoffman to a network and to allow accepting the destination from a portable device in

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order to facilitate communication between the customer and the business location and to allow the computer to select the business location nearest to the customer location.

As to claim 2, refer to claim 1 above. Further, using GPS to determine the position of a device would have been known.

As per claim 14-15, refer to claims 1, 2 above.

5. Claims 3-8, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Jr. et al (US 5,197,009) in view of Stewart et al (US 6,259,405) and further in view of Machii et al (U.S Patent No. 6,324,467).

As per claim 3-8, 16-19, Machii teaches storing a user information at a location corresponding to the user ID (col.11, lines 25-27), and charging service to the user (col.11, lines 25-32), and deleting the destination (col.15, lines 20-23). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to store the destination data of Hoffman to the location corresponding to user ID in order to facilitate retrieving the customer record. Further, with respect to claims 7-8, charging a sponsor instead of charging the user, and including advertising messages of the sponsor, informing the user of the deleting of a stored information would have been well known.

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6. Claims 9-11, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman, Jr. et al (US 5,197,009) in view of Stewart et al (US 6,259,405) and further in view of Takayama et al (US 2001/0056443).

As per claim 9-11, 20-22, Takayama teaches allowing the user to set the time of departure (paragraph [0358], [0361], [0398],[0416]-[0421]). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the user or the delivery personel of Hoffman to specify the departure time in order to facilitate planning for the navigation before the actual travel.

Response to Arguments

7. Applicant's arguments with respect to claims 1-11, 14-22 have been considered but are moot in view of the new grounds of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 305-7687 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")


Hand-delivered responses should be brought to Crystal Park V, 2451 Crystal
Drive, Arlington, VA., Seventh Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Nguyen whose telephone number is (703) 306-9130. The examiner can normally be reached on Monday-Thursday from 8:00 am to 6:00 pm ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, can be reached on (703) 308-3873. The fax phone number for this Group is (703)305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1113.


THU V. NGUYEN
PRIMARY EXAMINER

October 9, 2003